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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,270	03/29/2004	Ahmed Phuly	20020066.CPP	2981
23595	7590	12/06/2004	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			COURSON, TANIA C	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,270

Applicant(s)

PHULY, AHMED

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-23 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 24-29 is/are rejected.
- 7) ☒ Claim(s) 3-13 and 30-32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>29MAR04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a) Claims 22 and 31 recite the limitation "a chain and wheels" in line 3, respectively, although the specification recites on page 2, line 9, "magnetic wheels" not a "a chain and wheels".
- b) Claims 23 and 32 recite the limitation "a circular band" in line 3, respectively, although the specification recites on page 2, line 9, "magnetic wheels" not a "a circular band".

Claim Objections

2. Claim 29 is objected to because of the following informalities: in line 4, "the pin sleeve" lacks antecedent basis. Appropriate correction is required.

3. Claims 30-32 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 21-23. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Howard (US 2,408,517).

Howard discloses in Figures 1-7, a pipe cutting device and associated method comprising:

With respect to claim 24:

- a) providing an adjustable template (Fig. 7, template 82) attached to the workpiece (Fig. 2, pipe 3), orbiting the axis of the workpiece with a tool carriage (Fig. 2, saddle member 2), axially extending and retracting a tool arm (Fig. 2, arm 37) and having a tool thereon (Fig. 2, torch 4), relative to the tool carriage (Fig. 2), controlling the axial position of the tool by the template guiding the axial position of the tool arm relative to the tool carriage (Fig. 2).

With respect to claims 25-28:

- a) a means for attaching an orbital tool carriage (Fig. 2, saddle member 2) to a workpiece (Fig. 2, pipe 3) such that the orbital tool carriage axially orbits the

workpiece (Fig. 2), a tool for operating on the workpiece (Fig. 2, torch 4), a means for axially moving the tool relative to the orbital tool carriage (Fig. 2, arm 37), a means for attaching an adjustable template to the workpiece (Fig. 7, template 82), a tracer arm (Fig. 2, follower 76) for engaging and following the template on the workpiece connected to the means for axially moving the tool relative to the orbital tool carriage (Fig. 2), such that the tool operates on the workpiece at the desired axial position as the tool orbits the workpiece (Fig. 2);

- b) the tool is attached to an axially extending tool arm which moves axially on the orbital tool carriage (Fig. 2);
- c) the tool is attached to an axially tool carriage which is moveably attached to an axially extending tool arm extending from the orbital tool carriage (Fig. 2);
- d) a flexible template on the workpiece having its free ends seamlessly connected and is attached to the workpiece (Fig. 7).

With respect to claim 29:

- a) forming a smooth faced flexible track (Fig. 7, template 82) around a work piece (Fig. 2, pipe 3) of a predetermined shape (Fig. 2), locking the track in position using a locking mechanism on the sleeve (Fig. 2) such that the track remains fixed while maintaining the predetermined shape (Fig. 2), attaching a work tool (Fig. 2, torch 4), having an adjustable length arm mechanism (Fig. 2, arm 37) and a motion system (Fig. 2), to the work piece (Fig. 2), such that

the tool can work on the work piece by allowing the adjustable arm mechanism to follow the track (Fig. 2) while the motion system allows the work tool to orbit the work piece and maintain its relative orientation and distance to the surface of the work piece (Fig. 2).

With respect to claim 29: The sleeve disclosed by Howard is considered to be in a broad sense, a “pin” sleeve since Howard clearly shows a “sleeve” in Fig. 7. Furthermore, the term “pin” does not add any structural limitation to the term “sleeve”, thus it does not provide enough patentable weight.

Allowable Subject Matter

6. Claims 3-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form correcting the double patenting and including all of the limitations of the base claim and any intervening claims.

7. Claims 14-23 are allowed.

REASONS FOR ALLOWANCE

8. The following is an examiner’s statement of reasons for allowance for Claims 1-13, based on the correction of double patenting: the prior art does not disclose or suggest a template including a plurality of adjacent parallel pins forming an array, a pin sleeve for engaging and slideably holding the pins in the array, a flexible track attached to a first end of the pins for

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forming a closed loop template, the track having a first fixed end being tapered to create a smooth joint as it forms the closed loop with the second free end, so as to allow for the adjustability of the length of the track, as the pins are moved relative to each other in combination with the remaining limitations of the claims.

9. The following is an examiner's statement of reasons for allowance for Claims 14-15: the prior art does not disclose or suggest a template including a plurality of adjacent parallel pins forming an array, a pin sleeve for engaging and slideably holding the pins in the array, a flexible track attached to a first end of the pins for forming a template as the pins are moved relative to each other, the pin sleeve has a guide for attaching a tool to move along the pin sleeve in combination with the remaining limitations of the claims.

10. The following is an examiner's statement of reasons for allowance for Claims 16-19: the prior art does not disclose or suggest a method of forming templates for tools to use including holding a plurality of pins in a pin sleeve, attaching a smooth faced adjustable length flexible track to one end of the plurality of pins, forming a track on the pin sleeve for guiding a tool in combination with the remaining limitations of the claims.

11. The following is an examiner's statement of reasons for allowance for Claims 20-23 and 30-32: the prior art does not disclose or suggest a method of forming templates for tools to use including forming a smooth faced flexible track around a workpiece by use of pins slideable in a pin sleeve and allowing an adjustable arm mechanism to follow the track while a motion system

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allows a work tool to orbit the work piece in combination with the remaining limitations of the claims.

12. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,601,312 to Phuly. Although the conflicting claims are not identical, they are not patentably distinct from each other because during normal use of the device claimed in the U.S. Patent, the template stated in the claims 1-2 of this application would be met, particularly since the apparatus claimed in the U.S. Patent has the same features as the apparatus stated in the method claims, e.g. (a plurality of pins cylindrically arrayed, a pin sleeve and an adjustable length flexible track)

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a pipe cutting device and method:

Schreib (US 3,464,685)

Galezniak (US 3,166,620)

Wheeler (US 2,990,169)

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
November 24, 2004